

REMARKS

Status

Claims 1-69 are pending and under examination. The sole remaining issues are rejections for statutory double patenting, which are traversed, and obviousness-type double patenting, which are overcome by submission of a Terminal Disclaimer.

Receipt of Applicants' Communication dated May 24, 2005, was not acknowledged in the Office Action. The undersigned Applicants' representative contacted Examiner Sines by telephone on July 27, 2005. Examiner Sines indicated that the Communication had been considered, and agreed that this would be noted in the next Office Action. Applicants thank the Examiner for the courtesy extended to the undersigned in connection with the telephone call.

Statutory Double Patenting

Claims 1-9 and 16 were rejected under 35 USC 101 as claiming the same invention as that of claims 1-21 of prior U.S. Patent No. 6,767,706 B2. The '706 patent issued from a continuation-in-part of the present application.

The claims of the '706 patent are directed to *methods* for mixing fluids and binding a sample to a target. The instant claims are directed to a *device*.

35 U.S.C. 101 prohibits double patenting of the 'same invention.' As the Office notes in paragraph 1 of the Office Action: "the term 'same invention,' . . . means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957)." Clearly a device and a method are not identical subject matter. Applicants therefore respectfully request that this rejection be withdrawn.

Obviousness-Type Double Patenting


Claims 10-15 and 17-69 were rejected under the doctrine of obviousness-type double patenting over claims 1-21 of U.S. Patent No. 6,767,706 B2 or the '706 patent in view of U.S. Pat. No. 6,408,878. Solely to expedite prosecution, Applicants submit herewith a terminal disclaimer, thereby overcoming the rejection. The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-462-5330.

Respectfully submitted,



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